

**This Page is Inserted by IFW Indexing and Scanning
Operations and is not part of the Official Record**

BEST AVAILABLE IMAGES

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images include but are not limited to the items checked:

- ☐ **BLACK BORDERS**
- ☐ **IMAGE CUT OFF AT TOP, BOTTOM OR SIDES**
- ☐ **FADED TEXT OR DRAWING**
- ☐ **BLURRED OR ILLEGIBLE TEXT OR DRAWING**
- ☐ **SKewed/SLANTED IMAGES**
- ☐ **COLOR OR BLACK AND WHITE PHOTOGRAPHS**
- ☐ **GRAY SCALE DOCUMENTS**
- ☐ **LINES OR MARKS ON ORIGINAL DOCUMENT**
- ☐ **REFERENCE(S) OR EXHIBIT(S) SUBMITTED ARE POOR QUALITY**
- ☐ **OTHER:** _____

IMAGES ARE BEST AVAILABLE COPY.

As rescanning these documents will not correct the image problems checked, please do not report these problems to the IFW Image Problem Mailbox.



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/059,346	01/31/2002	Takayuki Ono	040894-5760	6054

9629 7590 09/07/2004

MORGAN LEWIS & BOCKIUS LLP
1111 PENNSYLVANIA AVENUE NW
WASHINGTON, DC 20004

EXAMINER

PATEL, GAUTAM

ART UNIT PAPER NUMBER

2655

DATE MAILED: 09/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/059,346

Applicant(s)

ONO, TAKAYUKI

Examiner

Gautam R. Patel

Art Unit

2655

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

1. This is in response to amendment filed on 6-30-04.
2. Claims 1-5 remain for examination. Claim 5 is newly presented for examination.

Claim Rejections - 35 U.S.C. § 112

3. The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 5 is rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Pages 6-7, line 24-25 & 1-18 simply states that "in a track-on state movement of the thread is started". The specification does not disclose at all that "an actuator is operated or that after a thread drive signal is detected actuator drive signal is simultaneously input with release of the track function". Also the only place specification talks about simultaneous function at all is on page 4, lines 12-23. However this page talks about kick signal being applied to thread and actuator, which has nothing to do with release of track function.

4. The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 5 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5, lines 2-4 "a thread drive signal is detected utilizing a track-on function, and an actuator drive signal is simultaneously input with the release of the track function", is confusing and unclear. It is not clear at all how a track-on function is being released. Track-on function needs to be functional all the time make sure that objective

Art Unit: 2655

lens is properly situated on the track. Also this aspect is not defined in the specification at all.

Claim Rejections - 35 U.S.C. § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action.

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 are rejected under 35 U.S.C. § 102(b) as being anticipated by Ikeda, US. patent 5,870,2356 (hereafter Ikeda).

As to claims 1-4, Takahashi discloses the invention as claimed [see Figs. 2-9, especially 6 & 7] including a thread, a lens moving unit, a thread moving unit and a movement controller, comprising:

a thread [inherently present in a seek control] on which a pick-up head [fig. 3, unit 184] is placed, said pick-up head serving to read data recorded on an optical disk [MO cartridge] by irradiating a track formed on a recording face of said optical disk with an optical beam focused by a lens and detecting the reflected light [col. 11, line 40 to col. 12, line 5];

a lens moving unit [fig. 7A and 7B, unit 58 & 60] adapted to move the lens of said pick-up head relative to said thread in a radial direction of said optical disk;

a thread moving unit [fig. 8, unit VCM 64] adapted to move said thread as well as said pick-up head in the radial direction of the optical disk [col. 11, line 40 to col. 12, line 5]; and

a movement controller [fig. 8, unit 15] adapted to control said thread moving unit to start movement of said thread while controlling said lens moving unit to perform track-on control so that the lens of said pick-up head is located on a prescribed track [col. 11, lines 16-39], and thereafter when it is detected that said lens has deviated from said prescribed track by a prescribed amount or more owing to movement of said

Art Unit: 2655

thread, starting the movement of said lens by said lens moving unit [col. 11, line 40 to col. 12, line 67],

wherein said movement controller detects whether or not said lens and said prescribed track have displaced from each other by a prescribed amount on the basis of whether a tracking servo signal has exceeded a prescribed potential, until said lens deviates from the prescribed track by a prescribed amount or more, controlling said thread moving unit to apply force having a prescribed magnitude to said thread continuously and when shifted by the prescribed amount or more, controlling said thread moving unit and said lens moving unit to control the moving speed of the lens at a constant speed [col. 11, line 40 to col. 12, line 67 and col. 13, lines 2-51].

6. As to claim 2, it is rejected for same reasons set forth in the rejection of claim 1, supra.

7. As to claim 3, Ikeda discloses:

until a center of said lens deviates from the prescribed track by a prescribed amount or more, said controller controls said thread moving unit to apply force having a prescribed magnitude to said thread continuously [col. 11, line 40 to col. 12, line 67 and col. 13, lines 2-51].

8. As to claim 4, Ikeda discloses:

when the center of said lens deviates from the center of said prescribed track by a prescribed amount or more, said controller controls said thread moving unit and said lens moving unit to control the moving speed of the lens at a constant speed [col. 11, line 40 to col. 12, line 67 and col. 13, lines 2-27].

9. A search based on the best understanding of the new claim 5 has been made to find the most pertinent art [see other art], but no statement about invention will be appropriate at this time regarding the allowableness of claim 5 and no art rejection will be made in this office action regarding the claim 5, due to the speculation required to

Art Unit: 2655

interpret the claims because of their indefiniteness under 35 U.S.C. 112, 1st and 2nd paragraphs as noted above (see *In re Steele*, 134 USPQ 292).

10. Applicant's arguments filed on 6-30-04 have been fully considered but they are not deemed to be persuasive for the following reasons.

11. In the REMARKS, the Applicant argues as follows:

A) That: "Applicants respectfully submits that Ikeda does not disclose at least " a movement controllersaid lens by moving unit," features as recited in independent claims 1 and 2, respectively." [page 7, para. 5; REMARKS].

FIRST : The Applicants have failed to define **which** limitation that they think Ikeda does not show.

SECOND: careful examination of rejection shows that ALL limitations are covered in detail for example, movement controller is defined as unit [fig. 8, unit 15], a lens moving unit [fig. 7A and 7B, unit 58 & 60], and a thread moving unit [fig. 8, unit VCM 64] etc. All these units are exactly functioning as claimed.

B) That: "In the present invention, the beginning of actual movement of the thread after the input of the thread drive signal is detected utilizing the track-on function, and the beginning of the actuator drive signal is input at the same time with release of the track-on state." [page 8, para. 1; REMARKS].

FIRST: It seems this limitation is being claimed in new claim 5, however the Applicants have failed to indicate where this limitation is in the specification while addressing the claim 5 on page 7.

SECOND: Please see paragraph 3-4 above.

C) That: " The Ikeda reference also shows what is already known in the prior art, i.e., after a lapse of prescribed time, a signal is applied to the lens actuator following

Art Unit: 2655

signal application to thread. See the specification at page 4, line 12 through page 5, line 13. As such, Ikeda cannot anticipate the present invention." [page 8, para. 2; REMARKS].

FIRST : What Ikeda prior art does not does not show is irrelevant and moot, since prior art of Ikeda was NOT used for the rejection.

SECOND: No paragraph starts from line 12 on page 4 [or column 4] and ends on page 5 [or column 5]. Assumption was made as to the location of this paragraph but no such text was found.

12. THIS ACTION IS MADE FINAL. See M.P.E.P. § 706.07(a).

Applicant's amendment necessitated the new grounds of rejection presented in this office action. Accordingly, THIS ACTION IS MADE FINAL. See M.P.E.P.

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact information

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gautam R. Patel whose telephone number is (703) 308-7940. The examiner can normally be reached on Monday through Thursday from 7:30 to 6.

The appropriate fax number for the organization (Group 2650) where this application or proceeding is assigned is (703) 872-9314.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Doris To can be reached on (703) 305-4827.

Art Unit: 2655

Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 305-4700 or the group Customer Service section whose telephone number is (703) 306-0377.

A handwritten signature in black ink, appearing to read "Gautam R. Patel", with a long horizontal stroke extending to the right.

Gautam R. Patel
Primary Examiner
Group Art Unit 2655

GAUTAM R. PATEL
PRIMARY EXAMINER

September 6, 2004